REMARKS

As to 37 C.F.R. § 1.116

To expedite prosecution, the preamble of Claims 18-20 has been amended. Accordingly, the amendments herein are directed towards a matter of form. As such, the amendments do not raise new issues or considerations and do not require a new search. Thus, this Amendment is entitled to entry pursuant to 37 C.F.R. § 1.116.

6. Claims 18-20 satisfy 35 U.S.C. 101.

Claim 18 has been amended and now recites:

> **A computer system** comprising a user interface, said user interface comprising:
> a window comprising base text cells and ruby text cells; and
> an automatic recognition toggle to activate and deactivate an automatic recognition function, wherein, when active, said automatic recognition function detects individual words in base text and identifies corresponding ruby text. (Emphasis added.)

Applicants respectfully submit that a "computer system comprising a user interface" is directed towards statutory subject matter.

For at least the above reason, Claim 18 satisfies 35 U.S.C. 101. Claims 19-20, which depend from Claim 18, satisfy 35 U.S.C. 101 for at least the same reasons as Claim 18. For the above reasons, Applicants respectfully request reconsideration and withdrawal of this rejection.

7/8/9) Claims 1-6, 9-16, 21, 22, 24, 25, and 27 are patentable over Madduri (6,567,830) in view of Durst et al. and further in view of Newbold et al. (5,576,955).

Regarding Claim 1, the Examiner admits:

> Neither Madduri nor Durst disclose a method in which the base text cell and ruby text cell are in a separate window than the working document. (Office Action, page 5.)

To cure this deficiency in Madduri and Durst et al., the Examiner further asserts:

> However, Newbold discloses a method in which the base text and **annotation text** are interfaced with in a separate window than the document, which causes a need for changing focus between the two windows in order to alter base text (Figures 5A and 5B and column 6, line 25-column 7, line 15 of Newbold). **It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Madduri and Durst with the method of Newbold because it would have allowed annotations to be viewed as a list and in turn handled collectively** (Office Action, page 5, emphasis added.)

The Examiner's statement is respectfully traversed. Applicants respectfully submit the Examiner has failed to make a prima facie obviousness rejection. Applicants note that to make a prima facie obviousness rejection, the MPEP directs:

> **BASIC CONSIDERATIONS WHICH APPLY TO OBVIOUSNESS REJECTIONS**
> When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to:
> (A) The claimed invention must be considered as a whole;
> (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
> (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
> (D) Reasonable expectation of success is the standard with which obviousness is determined.

MPEP § 2141, eighth edition, Rev. 3, August 2005, p. 2100-125. It is noted that this directive stated "the following tenets . . . **must be adhered to**." Accordingly, failure to adhere to any one of these tenets means that a prima facie obviousness rejection has not been made.

The rejection fails to adhere to multiple of these tenets. As demonstrated more completely below, the references have not been considered as a whole and the references do not suggest

the desirability of making the combination. Pieces of the references have been extracted and selectively interpreted in view of Applicants' claims.

Applicants note that Newbold et al. as a whole is directed towards correction of errors, not annotations. More particularly, Newbold et al. teaches that errors **are replaced with** corrected text. To illustrate, Newbold et al. teaches:

> FIG. 6A illustrates the condition of the screen is the Correct function is selected to correct "all agree" with "agree." **In Text Window, the phrase "all agree" is replaced with "agree." "All agree" is removed from the Error List.** (Col. 6, lines 37-41, emphasis added.)

Thus, instead of considering Newbold et al. as a whole as teaching error replacement, the Examiner has selectively interpreted Newbold et al. in view of Applicant's claimed invention as teaching "Newbold discloses a method in which the base text and **annotation text** are interfaced with in a separate window than the document". Applicants respectfully submit that one of skill in the art would have no motivation to combine the error replacement teaching of Newbold et al. with the teaching of Madduri, or Durst et al.

Accordingly, Applicants respectfully submit that the Examiner has failed to callout where Madduri, Durst et al. and Newbold et al., either alone or in combination, suggest the desirability of the combination.

Accordingly, Claim 1 is allowable over Madduri in view of Durst et al. and further in view of Newbold et al. Claims 2-6, 9-11, which depend from Claim 1 are allowable for similar reasons to Claim 1.

Claims 12, 16, 21, 24, 27 are allowable for reasons similar to Claim 1. Claims 13-15, which depend from Claim 12, are allowable for at least the same reasons as Claim 12. Claims 22, 25, which depend from Claims 21, 24, are allowable for at least the same reasons as Claim 21, 24, respectively.

For the above reasons, Applicants respectfully request reconsideration and withdrawal of this rejection.

10) Claims 8 and 17-20 are patentable over Madduri in view of Durst et al. further in view of Newbold et al. and further in view of Collins et al. (5,594,642).

As set forth above, Claim 1 is allowable over Madduri in view of Durst et al. further in view of Newbold et al. Claim 8, which depends from Claim 1, is allowable over Madduri in view of Durst et al. further in view of Newbold et al. for at least the same reasons as Claim 1.

The Examiner has failed to callout how Collins et al. cures the above described deficiencies in Madduri in view of Durst et al. further in view of Newbold et al. Accordingly, Claim 8 is allowable over Madduri in view of Durst et al. further in view of Newbold et al. and further in view of Collins et al. Claims 17-20 are allowable for reasons similar to Claim 8.

Further, regarding Claim 18, the Examiner admits:

> None of Madduri, Durst, or Newbold disclose a method in which it is determined whether or not an automatic ruby determination function is on or off… (Office Action, page 14.)

To cure this deficiency in Madduri, Durst et al. and Newbold et al., the Examiner further asserts:

> However, Collins discloses a method in which **an automatic annotation function** is used **and is considered off if the program is in manual mode,** on if it is in automatic mode … (Office Action, page 14, emphasis added.)

The Examiner's statement is respectfully traversed. As set forth in the Amendment filed on June 24, 2005 at page 14, Collins et al. teaches:

> FIG. 6 demonstrates the processing of text using various input methods. The general process involves

> **input of text 600, conversion of the text**, which is
> shown to the user at 602, user interaction with the
> text at 604, and either converting the text with the
> user selections at 606, and confirming the conversion
> process 608. (Col. 5, line 9 to line 17, emphasis
> added.)

Accordingly, Collins et al. is directed to conversion of
text, and the Examiner has failed to callout where Collins et
al. teaches or suggests "an automatic annotation function" as
asserted by the Examiner. Further, Applicants respectfully
request that the Examiner identify with specificity where
Collins teaches or suggest that the program can be in a manual
mode as asserted by the Examiner.

In response to Applicants' argument, the Examiner now
asserts:

> Collins discloses a method in which it is determined
> whether or not an **automatic translation (annotation)
> function** is on **or off**, if it is on ... (Office Action,
> page 16, emphasis added.)

Applicants note the Examiner continues to assert that the
automatic translation (annotation) function can be on or off.
Applicants requested that the Examiner identify with
specificity where Collins teaches or suggest that the program
can be in a manual mode as asserted by the Examiner, yet the
Examiner failed to callout where Collins teaches or suggest
that the program can be in a manual mode. In addition,
Applicants note the Examiner has failed to callout where
Madduri, Durst et al., Newbold et al., Collins et al. teach or
suggest "said user interface comprising ... an automatic
recognition toggle to active and deactivate an automatic
recognition function" as recited in Claim 18, emphasis added.

Accordingly, Claim 18 is allowable over Madduri in view of
Durst et al. further in view of Newbold et al. and further in
view of Collins et al. Claims 19-20, which depend from Claim
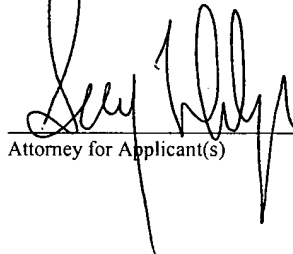18, are allowable for at least the same reasons as Claim 18.

For the above reasons, Applicants respectfully request reconsideration and withdrawal of this rejection.

Conclusion

Claims 1-6, 8-22, 24-25, and 27 are pending in the application. For the foregoing reasons, Applicants respectfully request allowance of all pending claims. If the Examiner has any questions relating to the above, the Examiner is respectfully requested to telephone the undersigned Attorney for Applicant(s).
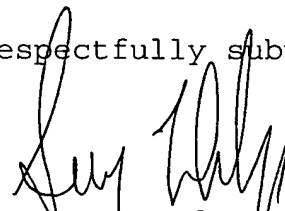
CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on November 4, 2005.

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